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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/801,352 | 03/16/2004 | Earl Roger Singleton | S146 1090.1 | 2122 |

7590 07/28/2005

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| EXAMINER |
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UPTON, CHRISTOPHER

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| ART UNIT | PAPER NUMBER |
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1724

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/801,352

Applicant(s)

SINGLETON, EARL ROGER

Examiner

Christopher Upton

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-8,10-12 and 14-16 is/are rejected.
- 7) ☒ Claim(s) 3,5,9 and 13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Mikell.

Mikell discloses a filter having a plurality of coils (14) contained within a water permeable cover (16), as claimed.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mikell in view of Chinn.

Claim 8 differs from Mikell in recitation of the cover being geotextile. It is submitted that this is a well known mesh material for outdoor use, as exemplified by

the Chinn patents, and would therefore have been an obvious mesh material for the cover of Mikell for one skilled in the art.

4. Claims 6, 7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Meier.

Meier discloses a filter comprising a plurality of fused coils (3) covered by a filter (1), as claimed. With respect to the recitation of a curb and grate inlet, it is submitted that this is intended use language there is no structural limitation recited.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meier.

Claim 11 differs from Meier in recitation of metal coils. It is submitted that, while Meier discloses that plastic is useful for making a chemically resistant filter, that the use of metal is well known, and would have been an obvious material for use in an environment where such chemical resistance is not required.

6. Claims 6, 7 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hobson.

Hobson discloses a filter comprising a coil with widely pitched and narrowly pitched sections, which obviously forms two (and therefore a plurality of) fused coils, as claimed. With respect to the recitation of a curb and grate inlet, it is submitted that this is intended use language there is no structural limitation recited.

7. Claims 1, 2, 4, 12 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egan in view of Chinn.

Egan discloses a permeable body for a storm drain in the form of a grating having two elevations, the second of which (44) is higher than the first (43), similar to that claimed. Egan does not disclose the encapsulation of the body in a filtering material. It is known to encapsulate a storm drain grating in a filtering material, such as geotextile, as disclosed by the two Chinn patents. It would therefore have been obvious for one skilled in the art to enclose the grating of Egan in such a filter material, to prevent silt and small debris from entering the drain.

8. Claims 3, 5, 9 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The recitation of a filter comprising a permeable body in the form of a plurality of coils having a section with a first elevation and a section with a second elevation higher than the first elevation covered by a filter material patentably distinguishes over the prior art of record.

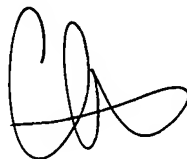
9. The following observation is made: on the IDS, it appears that Patent numbers 248,557 and 3,379,913 are typographical errors, as 248,557 is not to Jackson, and discloses a watch pinion; while 3,379,913 is not to Bogosian and discloses a CRT. A supplemental IDS listing the proper patents should be submitted, if it is wished that these references be considered and made of record.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other references of interest include Carpenter, Jones, Maki, Vidal, Schneider, Harms, Harris, Roesner and Singleton ('579).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Upton whose telephone number is 571-272-1169. The examiner can normally be reached on 7:30-5:00, off every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher Upton
Primary Examiner
Art Unit 1724